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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,894	07/05/2001	Kiyoshi Taniguchi	210100US0PCT	8683

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
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EXAMINER

WRIGHT, SONYA N

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/868,894	TANIGUCHI ET AL.	
	Examiner	Art Unit	
	Sonya Wright	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 17-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 10 and 17-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 10 and 18-31 are pending in this application. The amendment filed September 29, 2003 will be addressed in the next office action. The finality of the previous office action is withdrawn in view of the following.

Election/Restrictions

Group I claims 10 and 18-31, wherein the process of claim 10 comprises reaction 1, classified in class 549 and various subclasses.

Group II claims 10 and 18-31 wherein the process of claim 10 comprises reaction 2, classified in class 549 and various subclasses.

Group III claims 10 and 18-31 wherein the process of claim 10 comprises reaction 3, classified in class 549 and various subclasses.

Group IV claims 10 and 18-31 wherein the process of claim 10 comprises reaction 4, classified in class 549 and various subclasses.

Group V claims 10 and 18-31 wherein the process of claim 10 comprises reaction 5, classified in class 549 and various subclasses.

Group VI claims 10 and 18-31 wherein the process of claim 10 comprises reaction 6, classified in class 549 and various subclasses.

Group VII claims 10 and 18-31 wherein the process of claim 10 comprises reaction 7, classified in class 549 and various subclasses.

Group VIII claims 10 and 18-31 wherein the process of claim 10 comprises reaction 8, classified in class 549 and various subclasses.

Group IX claims 10 and 18-31 wherein the process of claim 10 comprises reaction 9, classified in class 549 and various subclasses.

Group X claims 10 and 18-31 wherein the process of claim 10 comprises reaction 10, classified in class 549 and various subclasses.

Group XI claims 10 and 18-31 wherein the process of claim 10 comprises reaction 11, classified in class 549 and various subclasses.

Group XII claims 10 and 18-31 wherein the process of claim 10 comprises reaction 12, classified in class 549 and various subclasses.

Group XIII claims 10 and 18-31 wherein the process of claim 10 comprises reaction 13, classified in class 549 and various subclasses.

Group XIV claims 10 and 18-31 wherein the process of claim 10 comprises reaction 14, classified in class 549 and various subclasses.

Group XV claims 10 and 18-31 wherein the process of claim 10 comprises reaction 15, classified in class 549 and various subclasses.

Group XVI claims 10 and 18-31 wherein the process of claim 10 comprises reaction 16, classified in class 549 and various subclasses.

Group XVII claims 10 and 18-31 wherein the process of claim 10 comprises reaction 17, classified in class 549 and various subclasses.

Group XVIII claims 10 and 18-31 wherein the process of claim 10 comprises reaction 18, classified in class 549 and various subclasses.

Group XIX claims 10 and 18-31 wherein the process of claim 10 comprises reaction 19, classified in class 549 and various subclasses.

Group XX claims 10 and 18-31 wherein the process of claim 10 comprises reaction 20, classified in class 549 and various subclasses.

Group XXI claims 10 and 18-31 wherein the process of claim 10 comprises reaction 21, classified in class 549 and various subclasses.

Group XXII claims 10 and 18-31 wherein the process of claim 10 comprises reaction 22, classified in class 549 and various subclasses.

In accordance with 37 CFR 1.499, Applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. Each Group contains structurally different reactants and reactive steps. Each Group contains processes that are chemically recognized as being divergent. For example, Group I is drawn to a process of preparing a compound of the formula (I-b) by removal of the carboxy-protective group of compound (I-a); Group II is drawn to a process of preparing a compound of the formula (I-b) by oxidizing the vinyl group of compound (II); Group III is drawn to a process of preparing a compound of the formula (I-d) by reducing compound (I-c); Group IV is drawn to a process of preparing a compound of formula (I-e) by reacting a compound of the formula (I-b) or its reactive derivative at the carboxy-group with a compound of the formula (IV); etc. . . . Accordingly, unity of invention is considered to be lacking, and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Each Group (supra) is drawn to a

patentably distinct process. Each process requires a different search with different considerations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday-Friday from 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

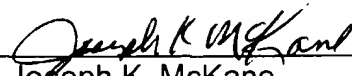
When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.



Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

November 13, 2003